



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,004	01/02/2002	Daniel R. Baum	Shutterfly 04C001	8059
7590 10/02/2006				
XIN WEN 2800 BRIDGE PARKWAY REDWOOD CITY, CA 94065			EXAMINER GARG, YOGESH C	
			ART UNIT 3625	PAPER NUMBER

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

**MAILED**

OCT 02 2006

**GROUP 3600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/038,004  
Filing Date: January 02, 2002  
Appellant(s): BAUM, DANIEL R.

---

Xin Wen  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed on 9/11/2006 appealing from the  
Office action mailed 8/12/2005.

Art Unit: 3625

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Application number 09/436,704. A Supplemental Appeal Brief was filed on 10/15/2004 and is still pending.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

20020103697A1	LOCKHART et al.	8-2002
5,960,411	HARTMAN et al.	9-1999

**(9) Grounds of Rejection**

The following ground(s) for rejection are reproduced below from the Non-Final Office Action, mailed on 8/12/2005, and are provided here for the convenience of both the Appellant and the Board of Patent Appeals:

Quote: "

***Detailed Action***

1. In view of the Supplemental Appeal Brief filed on 1011512004 PROSECUTION IS THEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Art Unit: 3625

2. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Claim Rejections - 33 LJSC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

**A person shall be entitled to a patent unless**

**(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351 (a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.**

Claims 1-10 and 13-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Lockhart et al. (US Publication 2002/0103697), hereinafter referred to as Lockhart.

Regarding claim 1, Lockhart teaches a computer-implemented method of distributing cards to a plurality of recipients, the method comprising:

Receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence (see at least page 2, paragraphs 0021-0023, teach specifying contents to be included in a card [such as postcard, folding-out card, or the like-which can include greetings cards, as suggested in paragraphs 6 and 11 ] for a recipient. The contents to be included in the card include images which, one or more, are directly uploaded by a user associated with that recipient [see paragraphs 0050-0062]. Lockhart also teaches that the order received specifying the contents for the said card can be addressed to a plurality of recipients [see at least paragraph 0086 " ....and from which the user may select one or more desired addresses (step 220..... ) and paragraph 0088, ".....For example, a single card design may be used for a variety of recipients.....]. Selection of one or more addresses corresponds to a plurality of recipients. Lockhart also teaches completing this single card order in a single transaction [see paragraph 0095 which teaches that after selecting recipient address [or addresses, as indicated above] the users account, if it has a positive balance, is debited in a single transaction sequence.);

for each of the plurality of recipients specified in the received card order, printing at least one card having at least one user-uploaded image from the recipient's image set (see at least paragraph 0100); and distributing the printed cards having the recipients' user-uploaded images to their respective associated recipients (see at least paragraph 0100 which discloses that after printing the cards they are mailed to their respective recipient addresses).

Regarding claim 2, Lockhart discloses that the card is one or more of a greeting card, a post card, and a playing card (see at least page 2, paragraphs 0021-0023, teach specifying contents to be included in a card [such as postcard, folding-out card, or the like-which can include greetings cards, as suggested in paragraphs 6 and 11]).

Art Unit: 3625

Regarding claim 3, Lockhart teaches that the images could differ from first recipient to a second recipient (see at least paragraph 0103, page 7 which discloses that the card content includes both fixed and variable data, wherein the variable data includes graphic data, that is images as they are specific to an individual recipient's card).

Regarding claim 4, Lockhart discloses that print parameters of a first recipient's cards differ from printing parameters of a second recipient's card and wherein the print parameters include one or more of print size, number of copies, print finish, and or textual message for the printed card(see at least paragraphs 0103-0110, page 7 which discloses that the card content includes both fixed and variable data, wherein the variable data includes graphic data, that is images as they are specific to an individual recipients card, destination address and text and all this data correspond to print parameters).

Regarding claim 5, Lockhart teaches that the images are uploaded by a user from a digital camera (see at least paragraphs 0028 and 0078 which teach uploading images from a video or digital camera).

Regarding claim 6, Lockhart teaches that images are uploaded by a user to a printing service (see at least paragraph 0023. It teaches uploading the images to a printing facilities 114. Note: The claim does not specify the details of uploading the images from the user. As known to one of an ordinary skilled in the art uploading of data means transfer of digital files from one computerized device to another device via a modem/network and Lockhart teaches the same in disclosing that the user's images are uploaded to the printing facilities from mail service computer 110 and mail service computer 110 received the images from the user's computing device.

Regarding claim 7, Lockhart teaches that receiving, printing and distributing is dispersed among two or more different entities ( see at least paragraphs 0021-0024 which teach receiving is done by mail service computer 110 and the printing is done by another entity "114" and distribution is done by third entity "120").

Regarding claim 8, Lockhart suggests that receiving, printing and distributing can be done by a single entity (see paragraph 0041, "....the printers and mail service computer may be located within the same general area....., which implies that receiving, printing and after printing mailing/distributing can be organized from one place.)

Regarding claim 9, Lockhart teaches that receiving a card order is performed by an enterprise providing a web front-end (see at least paragraphs 0038-0039, which discloses that the mail service computer 110 provides a suitable website.....).

Regarding claim 10, Lockhart teaches that the claim one further comprising, prior to printing, dividing the received card order into a plurality of sub-card orders, each sub-card order corresponding to a different recipient (see at least paragraphs 0086-0088. A single card can be sent to a variety of recipients with different addresses and that implies that the single card order is split into different sub-cards to be printed and mailed to different addresses).

Art Unit: 3625

Regarding claim 13, Lockhart teaches that the card order further comprises charging to one or more of a credit card, a debit card.....( see at least paragraph 0095).

Regarding claims 14-21, their limitations are closely parallel to the limitations of claims 1-10 and 13, as analyzed above and are therefore analyzed and rejected on the same basis.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

**(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.**

Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lockhart and further in view of Hartman et al. (US Patent 5,960,411), hereinafter referred to as Hartman.

Regarding claims 11 and 12, Lockhart does not disclose that single transaction sequence is terminated by an order icon or a click of a card-order button. However, in the same field of endeavor of online ordering, Hartman discloses that the single transaction sequence is terminated by a click of an order icon or a "card order" button. (see at least col.2, lines 50-57, "*An embodiment of the present invention provides a method and system for ordering an item from a client system..... The client system displays information that identifies the item and displays an indication of an action (e.g., a single action such as clicking a mouse button) that a purchaser is to perform to order the identified item.....*". Note: In Hartman, a ***single action such as clicking a mouse button***' corresponds to a click of "card order" button or an order icon as claimed.). In view of Hartman, it would have been obvious to a person of an ordinary skill in the art at the time of the applicant's invention to have modified Lockhart as applied to claim 1 to incorporate the Hartman's teachings of terminating the single transaction sequence by a *click* of an order icon or a "card order" button because such ordering system reduces the number of purchaser interactions needed to place an order and reduces the amount of sensitive information that is transmitted between a client system and server system, as explicitly taught in Hartman (see at least col.3, lines 30-37)."

Unquote:

**(10) Response to Argument**

**I. Whether claims 1-10 and 13-21 are anticipated by Lockhart.**

Regarding claim 1, the applicant argues that Lockhart discloses a method for generating and distributing mail items (see page 7-8, " Lockhart relates to a method for generating and distributing mail items.....The mail items are then delivered to the postal addresses of the intended recipients .....Here, Lockhart fails to show a number of claimed elements and thus cannot anticipate claim 1"). In response to applicant's argument that Lockhart relates to a method for generating and distributing mail items....., the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). The applicant has not showed or pointed out any errors or evidence contrary to the examiner's interpretation and analysis in rejecting following limitations of claim 1, given below:

" Receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single. card order is completed in a single transaction sequence (see at least page 2, paragraphs 0021-0023, teach specifying contents to be included in a card [such as postcard, folding-out card, or the like-which can include greetings cards, as suggested in paragraphs 6 and 11 ] for a recipient. The contents to be included in the card include images which, one or more, are directly uploaded by a user associated with that recipient [see paragraphs 0050-0062

for each of the plurality of recipients specified in the received card order, printing at least one card having at least one user-uploaded image from the recipient's image set (see at least paragraph 0100); and distributing the printed cards having the recipients' user-uploaded images to their respective associated recipients (see at least paragraph 0100 which discloses that after printing the cards they are mailed to their respective recipient addresses).".

The applicant argues (see page 9) that paragraphs 86 and 88 do not teach " a card order specifying a plurality of recipients and, for each specified recipient, as et of one or more images directly uploaded by a user associated with that recipient, wherein



Art Unit: 3625

the single card order is completed in a single transaction sequence, “. The examiner respectfully disagrees because examiner, in his rejection, pointed to paragraphs 0006, 0011, 0021-0023 and 0050-0062 in Lockhart, which disclose/suggest “ *Receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient*”, see the Office action reproduced above. The applicant has not showed or pointed out any errors or evidence contrary to the examiner’s interpretation and analysis in rejecting said limitations of claim 1. See Fig.1 where the Mail Service Computer 110 receives an order from the user system 102 via a network specifying contents for a recipient to be included in the intended mail and the intended mail to be sent to the recipient includes a postcard, letter, a folding card, etc. wherein graphics and text as specified by the user can be inserted. Paragraphs 0049-0062 disclose uploading images that can be inserted in the postcards [ paragraphs 0053 and 0062]. Paragraphs 0086, 0088 and 0095 disclose that such ordered postcards/folding cards, etc. are addressed to a plurality of recipients and are accordingly distributed among them. Once the specifics of the card design, quantities, number of recipients are finalized the purchasing transaction for all the ordered cards to be received by different recipients is completed in a single transaction sequence by confirming the purchase and indicating authorization to charge the debit or credit card of the user (see paragraph 0095). User, in Lockhart, is not required to enter into different or separate transactions for individual recipients intended to receive the ordered cards and that ‘s exactly what the examiner has interpreted from the limitation, “completing the single card order in a single transaction sequence “ recited in claim 1.

The applicant argues (see pages 9-10) that paragraph 95 teaches *that for each recipient separate transactions are carried out in seriatim* and does not suggest completing the order in a single transaction. The examiner respectfully disagrees because the paragraph 95 explicitly teaches an embodiment wherein the user is able to purchase a plurality amount of postcards and only after selecting the quantity, that is 10 or 25 or more he is allowed to complete the transaction for all the selected cards in one transaction sequence, " Depending upon the particular embodiment, the user may be able to purchase an arbitrary amount of postcards. Or the user may be presented with a choice of discrete quantities (1, 10, 25, etc.). In any event, the user is then prompted for suitable charge or debit card information, after which the user can confirm the purchase. The charge or debit is preferably authorized in conjunction with the appropriate credit authorization system 116 (for example, Visa, MasterCard, etc.)".

Note: The plurality of postcards selected are meant for more than one recipients, see paragraph 0086, " After entering the note and moving forward, the user selects the address of the desired recipient 130 (steps 216-220). This is preferably accomplished using an address book scheme, wherein the user is presented with an address book (step 216), which may be augmented or otherwise modified (step 218), and from which the user may select one or more desired addresses (step 220). In a preferred embodiment, the displayed address book includes a number of entries which may be selected via a standard checkbox. Each entry details the name (first and last), organization (if applicable), and postal address of the potential recipient. "Action" links are preferably provided to allow the user to edit or delete each particular entry. Furthermore, the address book is preferably segmented into groups or subsets (e.g., personal, professional, etc.). "

Further, in response to the applicant's arguments [see page 10 " Figure 2 in Lockhart clearly shows before a new card is considered in step 230, the previously card has been purchased (step 206), entered all the content (steps 208-218), address

Art Unit: 3625

(step 220), reviewed and scheduled (step 224), postage charged (step 226), and sent (step 228). The order for the previous card has been completed before the user starts the design of a new card.”], these arguments are not relevant as Lockhart anticipates the limitations of claim 1, as analyzed above.

Applicant’s arguments against rejection of claims 2-10 & 13, 14-15, 16-21 (see pages 10-21) are similar or closely parallel to the arguments presented against rejection of claim 1 (see pages 7-10) and are therefore analyzed and found not persuasive based on the same rationale as presented above in refuting the applicant’s arguments against claim 1.

## **II. Whether claims 12-13 are Unpatentable under section 103 (a) over Lockhart and Hartman.**

The applicant argues (see pages 27-28, “ Applicants respectfully traverse the assertion that Hartman shows the claimed receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence.....Hence Hartman fails to show the claimed element”). The examiner disagrees because the applicant is attacking Hartman’s reference individually whereas the examiner has used the combined prior art of Lockhart and Hartman to render the limitations of claims 11 and 12 obvious. In response to applicant’s arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

Art Unit: 3625

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Lockhart, as analyzed above and also shown in the office action reproduced above, teaches the limitations, "receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence.....", which are recited in claim 1. Examiner combined Hartman's teaching of terminating the transaction sequence by clicking an order icon/button.

The applicant argues (see page 28, " Additionally, the combination of Lockhart and Hartman is improper because ..... Even though Hartman shows a single action such as clicking a mouse button that a purchaser is to perform to order the identified item.....Hence, the cited disclosures cannot render dependent claims 11-12 obvious"), that Lockhart and Hartman cannot be combined because Lockhart does not teach the limitations of claim 1, "receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence.". The examiner respectfully disagrees with the applicant for reasons already analyzed above wherein it was demonstrated that Lockhart does anticipate claim 1 including the limitations receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images

Art Unit: 3625

directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence.

The applicant argues (see pages 28-29) that that the present rejection does not establish prima facie obviousness under 35 U.S.C. § 103 and M.P.E.P. §§ 2142-2143 because first the references fail to teach or suggest all the claim limitations of the independent claims that is the limitations of claim 1 and secondly there is no motivation to modify Lockhart to include the teachings of Hartman. The examiner respectfully disagrees for following reasons:

(i) It is already analyzed above that Lockhart teaches/suggests all the limitations of the independent claim 1. Teachings of Hartman were combined to overcome the deficiency of the limitations recited in claims 11 and 12, that is terminating the single transaction sequence by clicking an order icon/button. Hartman discloses that the single transaction sequence is terminated by a click of an order icon or a "card order" button (see at least col.2, lines 50-57, "An embodiment of the present invention provides a method and system for ordering an item from a client system..... The client system displays information that identifies the item and displays an indication of an action (e.g., a single action such as clicking a mouse button) that a purchaser is to perform to order the identified item.....". Note: In Hartman, a **single action such as clicking a mouse button** corresponds to a **click** of "card order" button or an order icon as claimed.). Therefore, the first condition that the cited references teach all the claimed limitations of claims 11 and 12 is satisfied to establish prima facie obviousness under 35 U.S.C. § 103 and M.P.E.P. §§ 2142-2143.

Art Unit: 3625

(ii) In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both the prior arts, that is Lockhart and Hartman, are directed to the same field of endeavor, that is conducting e-commerce of receiving repetitive orders from consumers online, such as for designing and distributing cards (Lockhart) and books and other commercial items (Hartman) and therefore, it would be clearly obvious to one of an ordinary skilled in the art at the time of the applicant's invention to incorporate the Hartman's teachings of terminating the single transaction sequence by a *click* of an order icon or a "card order" button because such ordering system reduces the number of purchaser interactions needed to place an order and reduces the amount of sensitive information related to credit/debit cards or bank accounts that is transmitted between a client system and server system, as explicitly taught in Hartman (see at least col.3, line 30-col.4, line 3).

The applicant also alleges (see page 28) the use of hindsight taught by the applicant's invention to combine the references of Lockhart and Hartman. In response to applicant's argument that the examiner's conclusion of obviousness is based upon

Art Unit: 3625

improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, it was obvious to one of an ordinary skilled in the art to combine the teachings of Lockhart and Hartman, as analyzed above, to arrive at the claimed invention.

### Hindsight

*In re McLaughlin*, 170 USPQ 209 (CCPA 1971)

"Any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within level of ordinary skill at time claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, reconstruction is proper."

The applicant's arguments (see page 30) related to reference Vaeck are not relevant as this reference is not used in rejecting the claims.

### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Yogesh C. Garg', written over a horizontal line.

Yogesh C. Garg  
Primary Examiner

Conferees

A handwritten signature in black ink, appearing to read 'John Weiss', written over a horizontal line.

John Weiss  
SPE AU 3629

A handwritten signature in black ink, appearing to read 'Jeffrey A. Smith', written over a horizontal line.

Jeffrey A. Smith  
SPE AU 3625